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On behalf of **Smith & Nephew, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MÖLNLYCKE HEALTH CARE AB,
Petitioner,

v.

SMITH & NEPHEW, INC.,
Patent Owner.

PGR2018-00035

Patent 9,642,750

SMITH & NEPHEW PRELIMINARY RESPONSE TO PETITION

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Pursuant to 37 C.F.R. § 42.207, 35 U.S.C. § 324, and the Notice of filing date accorded (Paper 4), Patent Owner Smith & Nephew, Inc., submits its Preliminary Response to Mölnlycke Health Care AB's ("Petitioner") Petition for Post-Grant Review of U.S. Patent No. 9,642,750 ("the '750 Patent").

I. INTRODUCTION

The Board should not institute post-grant review of the '750 Patent because post-grant review is available only for patents subject to the first-inventor-to-file ("FITF") provisions of the America Invents Act ("AIA"). The '750 Patent, which issued from Application No. 15/018,724 ("the '724 Application"), claimed priority to a series of provisional applications filed in 2009 and 2010. The second of those provisional applications, No. 61/332,440 ("the '440 Application"), which was filed on May 7, 2010, clearly and unambiguously disclosed the invention embodied in all of the claims of the '750 Patent. Because, under *Ariad*, the '440 Application need only reasonably convey to those skilled in the art that the inventors had possession of the claimed invention, the '750 Patent is entitled to an effective filing date of May 7, 2010, and is therefore not eligible for post-grant review.

Petitioner fails to carry its burden to show otherwise. First, Petitioner argues that claim 18 lacks written description support, in part, because it was copied from a co-pending MHC patent application during prosecution of the '724 Application. But the fact that Smith & Nephew sought to provoke an interference is irrelevant to

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